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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,121	04/13/2001	Margaret M. Leahy	OSJ-002RCE4	4218
959 7590 02/25/2009 LAHIVE & COCKFIELD, LLP FLOOR 30, SUITE 3000 ONE POST OFFICE SQUARE BOSTON, MA 02109			EXAMINER HOFFMAN, SUSAN COE	
			ART UNIT	PAPER NUMBER
			1655	
			MAIL DATE	DELIVERY MODE
			02/25/2009 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

09/835,121

Applicant(s)

LEAHY ET AL.

Examiner

Susan Coe Hoffman

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

1. The amendment filed November 11, 2008 has been received and entered. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior Office action.
2. Claims 11, 14, 21-25 and 27-32 are pending.
3. In Paper No. 5, applicant elected with traverse phenolic acid, specifically cinnamic acid for species D.
4. Claims 11, 14, 21-25 and 27-32 are examined on the merits solely in regards to the elected species.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 11, 14, 21-25 and 27-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Mantius (US 5,320,861) in light of Richards (US 2005/0175762) and Porter (J. Sci. Food Agric. (2001), vol. 81, pp. 1306-1313) as evidence of inherent characteristics of Mantius.

Applicant's claims are drawn to a composition comprising decharacterized cranberry enriched for cinnamic acid. Applicant's specification define "decharacterized cranberry" as "fruit from which the juice has been extracted..." such as a presscake or Tomah presscake as described in US Patent No. 5,320,861 (see page 6, first paragraph).

Mantius teaches the Tomah presscake as defined by applicant. The reference teaches infusing the presscake with an infusion syrup made from cranberry juice (see column 10, lines 23-31).

The reference does not specifically teach that the combination of the pomace and the juice produces a pomace that is enriched in cinnamic acid. However, Richards and Porter both teach that cinnamic acid compounds are naturally present in cranberry juice (see paragraph 73 of Richards and Table 1 of Porter). Thus, the pomace and juice composition of Mantius is enriched in cinnamic acid because the presscake infused with the juice would have more cinnamic acid than naturally present in the presscake without the infusion of the juice.

Mantius does not teach that the composition has the same pharmaceutical properties claimed by applicant. However, these are considered to be recitations of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed

invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

6. Claims 11, 14, 21-25 and 27-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Mann (US 6,231,866) in light of Richards (US 2005/0175762) and Porter (J. Sci. Food Agric. (2001), vol. 81, pp. 1306-1313) as evidence of inherent characteristics of Mann.

Mann teaches a pharmaceutical composition made by expressing the juice from cranberry to form a pomace. The reference defines "pomace" as a synonym to "presscake". The expressed juice is then used to infuse the pomace. The composition is used as a dietary supplement or as a food (see column 3, lines 49-65, column 4, lines 55-65, column 5, lines 2-11, column 6, lines 27-29).

The reference does not specifically teach that the combination of the pomace and the juice produces a pomace that is enriched in cinnamic acid. However, Richards and Porter both teach that cinnamic acid compounds are naturally present in cranberry juice (see paragraph 73 of Richards and Table 1 of Porter). Thus, the pomace and juice composition of Mann is enriched in cinnamic acid because pomace and juice composition would have more cinnamic acid than naturally present in the pomace without the addition of the juice.

Applicant's claims state that the composition contains the cinnamic acid in amounts greater than the amounts found in Tomah presscake. Table 12 in applicant's specification shows that Tomah presscake contains 10.52% phenolics but does not disclose a specific amount of cinnamic acid that is present. The Office does not have the ability to analyze the Tomah presscake to determine exactly how much cinnamic acid is present. Thus, for the sake of examination, any decharacterized cranberry product that is enriched in cinnamic acid is assumed

to contain more cinnamic acid than found in Tomah presscake. Note that MPEP § 2113 states that:

Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983).

Thus, applicant can overcome this rejection with a showing of evidence that the product in Mann does not contain as much cinnamic acid as the Tomah presscake or the claimed product.

Mann does not teach that the composition has the same pharmaceutical properties claimed by applicant. However, these are considered to be recitations of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

7. No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe Hoffman whose telephone number is (571) 272-0963. The examiner can normally be reached on Monday-Thursday, 9:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susan Coe Hoffman/
Primary Examiner, Art Unit 1655

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